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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,412	09/25/2003	David Weagle	P-3700-14	5050
22918	7590	03/24/2005	EXAMINER	
PERKINS COIE LLP P.O. BOX 2168 MENLO PARK, CA 94026			LUBY, MATTHEW D	
			ART UNIT	PAPER NUMBER
			3611	

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/669,412

Applicant(s)

WEAGLE, DAVID

Examiner

Matt Luby

Art Unit

3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/30/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group IV claims 9 and 10 in the reply filed on 12/21/04 is acknowledged. The traversal is on the ground(s) that a) the search and examination of all of the groups can be made without a serious burden to the examiner and b) the different groups do not relate to inventions properly classified as independent and distinct. This is not found persuasive because:

a) the Groups were listed with separate subclasses which the Examiner would not otherwise have to search unless the various distinct and independent Groups were examined together.

b) MPEP 816 points to the reasons an Examiner should give for holding of Independence or Distinctness. This was done because for each group it was pointed out why the subcombination was thought to have utility by itself or in other combinations and why the combination as claimed does not rely on the subcombination as its essential distinguishing part. Applicant's brief citation of MPEP 806.04 is appreciated but is not really on point. While it is true that an article of apparel such as a shoe and a locomotive bearing are an example of the independent nature of two different combinations, that quote by Applicant on page 4 of their response was not a complete recitation of MPEP 806.04. The three examples listed there are merely exemplary of specific situations that are noted as independent inventions. None of (A), (B) or (C) even covers a combination-subcombination relationship and the showing of

independent or distinct but the Examiner has followed the required practice to show such as outlined in MPEP 816.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Group/Invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 12/21/04.

### ***Drawings***

3. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because Informal Drawing Figures 1-3 are unclear. Furthermore, and with more particularity as pointed out below in subsequent drawing and specification objections, Figures 2 and 3 do not match with Figure 1. For example, it is unclear where the horizontal, bar starting at pivot point 50 and angled south-west from there is located in Figures 2 and 3. Perhaps this is due to the blurring of many of the structural features in Figures 2 and 3. Nevertheless, new drawings are necessary. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

***Specification***

4. The disclosure is objected to because of the following informalities: the word "oriented" should be inserted between "horizontally" and "pair" on page 3, line 17.

The following is a discussion with specific points, of how the specification, when taken together with an examination of the drawings, renders both unclear.

First, Applicant states that there is a cylindrical configuration, 24, "for journaling in rotation the rotor of 26 of the pedal mechanism 16" on page 3, lines 14-15. This does not mesh with the later description that "brackets 80 and 82 [are] connected at opposite ends 84 to cooperating openings 86 provided in the rear wheel supports 32 and 34 and at ends 88 to the cylindrical configuration 24" on page 4, lines 4-6. The reason these separate statements in Applicant's specification do not mesh is while Figures 1 and 3 make particularly clear the inherently obvious feature of a shaft, 24, for mounting and journaling the rotor of the pedal cranks, 16, this is most definitely not depicted as the same "cylindrical configuration" to which the ends, 88, of the rear wheel supports 32 and 34, are mounted as stated on page 4, lines 4-6. Therefore it is unclear, when the drawings and specification are considered in conjunction, where exactly the ends, 88, of the chain stays, 32 and 34, are really mounted since the drawings and the specific disclose different mounting points. This lack of clarity makes it almost impossible to determine what the structural configuration of the lower half of the suspension is. Basically the disclosure of everything between the points 92 at the southwest, 64 and 72 at the northeast and the brackets 42 and 44 at the southeast on an imaginary triangle is not understood.

Secondly, Applicant states that the pair of triangular brackets 60 and 62 are connected at 64 to cooperating openings provided in rear wheel supports 32 and 34 at page 3, line 23 - page 4, line 1. This is certainly not what the drawings show. It is believed that Applicant may have intended to label 32 and 34 as 28 and 30 here since those are what the triangular brackets, 60 and 62, are connected to.

Thirdly, Applicant states that "it will be understood that the interconnections at 48, 72 and 76 enable interconnected components to partake of a multitude of pivotal traverses" on page 4, lines 7-9. It is clear that 56 will pivot forward and back about pivot point 48. It is also clear that the triangular bracket pivots forward and back about pivot point 72. However, it is unclear how the welded attachment of support brackets 74 and 76 at point 78 "enable[s]...interconnected components to partake of a multitude of pivotal traverses". There is no "interconnection" at point 76 as there is at points 48 and 72. This reference numeral is a bracket, not a pivot point like 48 and 72.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Castellano (U.S. Patent No. 5,474,318).

Castellano discloses a compressible linkage suspension system for a bicycle rear wheel comprising: a spring damper unit (36); a frame member which supports a bicycle seat (66) and which further supports the spring damper unit (shown in Figure 1, for example); and a pair of triangular brackets (94) supporting the spring damper unit (shown in Figure 1, for example), wherein the spring damper unit partakes in pivotal traverses to achieve an anti-squat response (col. 19, lines 31-41, for example), wherein the anti-squat response is higher in the beginning of the suspension travel and lesser thereafter (since the definition of anti-squat is, as Applicant put it on page 1 of the specification, is "the resistance to rear suspension compression during the beginning of the travel", col. 19, lines 41-42 discloses this much, i.e., an anti-rise type suspension; wherein anti-rise is defined as the effort required to compress the suspension decreases through suspension travel at col. 9, lines 16-33 of U.S. Patent No. 6,103,421 of Lawwill et al.)

While Lawwill et al. is relied upon above, it is noted that the Court of Appeals for the Federal Circuit has permitted extra references or other evidence to be used to show the meaning of a term used in a primary reference. *In re Baxter Travenol Labs.*, 952 F.2d 388, 21 USPQ2d 1281 (Fed. Cir. 1991). Here, Lawwill et al. is used to explain to both the Applicant and any subsequent readers of the prosecution history of this application what the term anti-rise means and how it is related to the increase and decrease in the rate of anti-squat over time since the disclosure of the present application did not really point out the relationship between these two terms of art in bicycle suspension systems.



Regarding the functional limitations in claims 9 and 10 that the “spring damper unit partakes in pivotal traverses to achieve an anti-squat response....which is higher in the beginning of the suspension travel and lesser thereafter”, Applicant is reminded of MPEP 2173.05(g) which points out “A functional limitation is an attempt to define something by what it does or by a property or characteristic it has, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients)”; and MPEP 2114 which states “While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997)”.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure because they relate to anti-squat compressible linkage suspension systems for the rear wheel of a bicycle.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matt Luby whose telephone number is (571) 272-6648. The examiner can normally be reached on Monday-Friday, 9:30 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6612. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Matt Luby  
Examiner  
Art Unit 3611

A handwritten signature in black ink that reads "Matt Luby". The signature is written in a cursive style with a large, sweeping "M" and a long, trailing flourish at the end.

M.L..  
March 18, 2005